

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**

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*ON*

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/962, 776 11/03/97 SCHERTLER

R 622/40901CO

<input type="checkbox"/>	EXAMINER
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ROSENBAUM, I

ART UNIT	PAPER NUMBER
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3726

*16*

DATE MAILED:

05/22/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No. <b>08/962,776</b>	Applicant(s) <b>Schertler</b>
	Examiner <b>Irene Cuda</b>	Group Art Unit <b>3726</b>

Responsive to communication(s) filed on Feb 14, 1900.

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1-34 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1-34 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). 13

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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**DETAILED ACTION**

*Specification*

1. The following errors in the specification should be corrected. The numeral 3 is called both the drive axis and the transport device. The numeral 5 is called both the transport arm and transport device. The numeral 21 is called both the storage disk and article. The numeral 19 is called both the disk or plate and the transport device. The numeral 23 is called both the bellows and grooves.

*Reissue Applications*

Claims 1-34 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the

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meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

In amendment A of the patented file, applicant re-wrote independent claim 1 to include the limitations of dependent claim 9 (which included dependent claim 8 as well). The examiner had indicated that this made the case allowable. Dependent claim 9 included the limitation “said arms comprising driving means” while dependent claim 8 included the limitations “said transport device comprising a transport arm for each said conveyor means, said arms projecting from said rotational axis”. These limitations were added to the only other independent claim, application claim 20 (patent claim 16) as well. The reissue proposes to eliminate the language “projecting from”. Applicant surrendered claims without the ‘projecting from language’ in order to secure issuance of the patent and therefore that subject matter may not be recaptured.

#### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1,3-8,10,11,15,16,18-24,28,30-34, rejected under 35 U.S.C. 102(b) as being clearly anticipated by JP109727.

Each element as recited in the claims is clearly taught in the reference.

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4. Claims 31-34 are rejected under 35 U.S.C. 102(b) as being anticipated by DE544.

Applicants failure to argue the previous rejection of these claims is considered an agreement that the reference is readable on these claims. Applicant is requested to submit to the office the translation of this document which they used to determine what is and is not taught.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2,9,12-14,17,25-27, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 109727.

JP 727 teaches the apparatus essentially as claimed but lacks a teaching of the opening areas being warped, gas inlet and pumping means, and the particulars of the holding means. However, it is considered an obvious matter of design choice as to what is supplied at each station, which would be based on the desired operations to take place there. Further, the particulars of the holding means are considered old and well known in the art and the particulars of the holding arrangement are not deemed to add any patentable subject matter to the claims. Also, the use of the warped opening is considered an obvious matter of design choice absent any showing of criticality.

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7. In view of the amendments in paper no. 15 a supplemental declaration complying with 37 CFR 1.175(b) is required

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner I. Cuda whose telephone number is (703) 308-1792.

*I. Cuda*  
*Seu3726*

IC

May 19, 2000